

REMARKS

Summary of the Official Action

The foregoing amendment and remarks that follow are responsive to the Office Action mailed October 5, 2005. In that Office Action, the Examiner objected to Claim 1 due to an informality. In addition, the Examiner provisionally rejected Claims 1-4 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-4 of co-pending U.S. Application No. 10/850,315. Furthermore, the Examiner rejected Claims 1-21 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention due to the Examiner's assertion of inconsistent designations for the same claim elements.

In addition, the Examiner rejected Claims 2-4 and 6-8 under 35 U.S.C. §101 asserting that the claimed invention is directed to non-statutory subject matter. Also, the Examiner rejected Claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,295,466 issued to Ishikawa et al. (hereinafter ISHIKAWA '466). The Examiner rejected Claim 2 under 35 U.S.C. §103(a) as being unpatentable over ISHIKAWA '466 as applied to Claim 1 and further in view of U.S. Patent No. 6,366,794 issued to Moussy et al. (hereinafter MOUSSY). Claims 5 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,579,498 issued to Eglise (hereinafter EGLISE) and further in view of U.S. Patent No. 6,659,948 issued to Lebel et al. (hereinafter LEBEL) and further in view of ISHIKAWA '466.

Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over EGLISE as modified by LEBEL and ISHIKAWA '466 and further in view of MOUSSY. The Examiner also rejected Claim 9-11 under 35 U.S.C. §103(a) as being unpatentable over EGLISE in view of LEBEL and ISHIKAWA '466 as applied to Claims 5 and 22 and further in view of U.S. Patent No. 6,546,268 issued to Ishikawa et al. (hereinafter ISHIKAWA '268). Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over EGLISE in view of LEBEL and ISHIKAWA '466 as applied to Claims 5 and 22.

The Examiner indicated that Claims 3, 4, 7, 8, 12-17, 19 and 20 would be allowable if rewritten to overcome the rejections under 35 U.S.C. §112, second paragraph, and to include all of the limitations of the base claim and any intervening claims. Claims 4, 7 and 8 were indicated as being allowable if rewritten to overcome the rejections under 35 U.S.C. §101 and 35 U.S.C. §112, second paragraph. Claim 4 was further indicated as being allowable if the double

patenting rejection were overcome in addition to overcoming the rejections under 35 U.S.C. §112, second paragraph, and under 35 U.S.C. §101. Finally, Claims 23 and 24 were objected to as being dependent upon a rejected base claim but were indicated as being allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims.

Objection to Claim 1

Claim 1 was objected to because of an informality wherein on line 29 of Claim 1, the term "RF" was suggested as being replaced with the phrase "radio frequency (RF)".

By this amendment, Claim 1 has been cancelled so that the objection advanced in relation thereto is now moot. However, all presently pending claims containing the "RF" term have been rewritten such that any objections issued in relation to Claim 1 are believed to be overcome.

Double Patenting Rejection of Claims 1-4

In the Office Action, the Examiner provisionally rejected Claims 1-4 are under the judicially created doctrine of obviousness-type double patenting as being unpatentable over co-pending U.S. Application No. 10/850,315 to Zhou (hereinafter ZHOU). The Examiner indicates that the claims of ZHOU only differ from those of the present application in that the preamble states that the bio-sensor system is powered by an electroactive polymer generator and that, other than this limitation, the claims of ZHOU read upon the claims of the present application.

Applicant submits herewith a terminal disclaimer in relation to ZHOU such that the provisional obviousness-type double patenting rejection is now believed to be overcome.

Rejection of Claims 1-21 under 35 U.S.C. §112

Claims 1-21 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner indicates that Claim 1 recites "a sensor assembly" on line 2 of the claim, "the sensor" on line 6 of the claim, "an implantable on-chip transponder" on line 8 of the claim, "a sensor" on line 12 of the claim, and "the sensor" on lines 35-36 of the claim. The Examiner asserts that the claim lacks sufficient antecedent basis for the limitation "the sensor" on line 6 and that it is unclear whether "the sensor" refers to "sensor assembly" on line 2, the "implantable on-chip transponder" on line 8, the "sensor" on line 12, or another sensor altogether. The Examiner also indicates that it is unclear as to which element "the

sensor” on line 35-36 refers and requests clarification of the claim language by using a consistent designation for the same element and distinct designations for different elements.

By this paper, Applicant has amended all presently pending claims to clarify terminology such that the above-noted claim rejection is now believed to be overcome. More particularly, references to the term “sensor assembly” have been deleted throughout the claim set. Furthermore, the claims have been amended to provide proper antecedent basis for the limitation “the sensor.” Furthermore, the recited language in the claims has been amended to provide a consistent designation for the same element and clearly distinct designations for different elements.

In this regard, Applicant believes the revised claim language better clarifies that the term “sensor” refers to the element that is configured to measure the physiological parameter of a patient and which is illustrated in Figures 8a and 8b by reference numeral 210 and which may be configured as a 2-pin or 3-pin glucose sensor. In contrast, the “on-chip transponder” may include the sensor (210) as a sub-component thereof. The on-chip transponder is illustrated in Figures 1a and 1b and is indicated in those figures by reference numeral 100.

Applicant believes that the above noted amendments to the recited language in the claims with regard to the “sensor” and the “on-chip transponder” overcomes the rejection advanced by the Examiner under 35 U.S.C. §112, second paragraph, and Applicant apologizes for any inconvenience caused the Examiner in relation thereto.

Rejection of Claims 2-4 and 6-8 under 35 U.S.C. §101

The Examiner rejected Claims 2-4 and 6-8 under 35 U.S.C. §101 indicating that the claimed invention is directed to non-statutory subject matter wherein Claims 2 and 6 recite the limitation “a glucose sensor having an electrode assembly in fluid communication with the patient’s blood.” The Examiner indicates that the blood, being a part of the human body, is non-statutory subject matter and therefore cannot be positively claimed and requests amendment of the cited limitation to overcome the rejection.

By this amendment, Applicant has amended Claims 3-4, 7-8 and 23-24 to revise the limitation to recite that the electrode assembly is “adapted to be placed in fluid communication with the patient’s blood.” New Claims 25 and 26 recite similar language such that the rejection advanced under 35 U.S.C. §101 is now believed to be overcome.

Claim Rejections under 35 U.S.C. §103(a)

The Examiner rejected Claim 1 under 35 U.S.C. §103(a) as being unpatentable over ISHIKAWA '466. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over ISHIKAWA '466 in view of MOUSSY. Claims 5 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over EGLISE in view of LEBEL and further in view of ISHIKAWA '466. Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over EGLISE as modified by LEBEL and ISHIKAWA '466 and further in view of MOUSSY. Claims 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over EGLISE in view of LEBEL and ISHIKAWA '466 and further in view of ISHIKAWA '268. Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over EGLISE in view of LEBEL and ISHIKAWA '466.

By this amendment, Claims 1-2 and 5-6 have been cancelled such that the rejection issue in relation thereto is now moot.

Claim 9 has been amended to depend from Claim 7 which was indicated as being allowable if rewritten to overcome the §112, second paragraph, the §101 rejection, and to include all of the limitations of the base claim and any intervening claims. Because Claim 7 is now believed to be in condition for allowance, Claims 9-11, which are dependent therefrom, are also believed to be in condition for allowance. Likewise, Claim 18 has been amended to depend from Claim 7 which, as noted above, is believed to be in condition for allowance. As such, the §103(a) rejection advanced by the Examiner in relation to Claim 18 is now believed to be overcome such that Claim 18 is also now believed to be in condition for allowance. Claim 22 has been cancelled such that the §103(a) rejection advanced in relation thereto is moot.

Allowable Subject Matter

The Examiner indicates that Claims 3, 4, 7, 8, 12-17, 19 and 20 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, and to include all limitations of the base claim and any intervening claims. Claims 4, 7 and 8 were indicated as being allowable if rewritten to overcome the §101 and §112 rejections mentioned above. Claim 4 was indicated as being allowable if the double patenting rejection were overcome in addition to the §112 and §101 rejections. Claims 23 and 24 were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

By this amendment, Applicant has amended Claim 3 to incorporate the subject matter of cancelled Claims 1 and 2. In addition, Claim 3 has been amended to address the §112, second

paragraph, rejection such that Claim 3 is now believed to be in condition for allowance. Claim 4 is dependent upon Claim 3 and is therefore also believed to be in condition for allowance.

Claim 7 has been amended to incorporate the limitations of cancelled Claims 5 and 6 in addition to being amended to address the §112 and §101 rejections such that Claim 7 is now believed to be in condition for allowance. All claims depending from Claim 7, namely, Claims 8-21, are therefore also believed to be in condition for allowance.

Claim 23 has been amended to incorporate the limitations originally set forth in Claims 22 and 23. In addition, Claims 23 and 24 have been amended to address the Examiner's rejections under §112 and §101 such that Claims 23 and 24 are now believed to be in condition for allowance.

New Claims 25 and 26 are similar in scope to amended Claims 3 and 4, respectively, with the exception that Claims 25 and 26 claim the "on-chip transponder" for a biosensor system having a remote transponder. Because Claims 3 and 4 are believed to be in condition for allowance, new Claims 25 and 26 are likewise believed to be in condition for allowance.

Conclusion

Applicant respectfully submits that the claims as amended and added are in condition for allowance. Should the Examiner have any suggestions for expediting allowance of the amended and new claims, the Examiner is invited to contact the Applicant's representative at the telephone number listed below.

If a fee is required, please charge Account Number 19-4330.

Respectfully submitted,

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By:



Sean O'Neill

Customer No. 007663

Registration No. 45,446

STETINA BRUNDA GARRED & BRUCKER

75 Enterprise, Suite 250

Aliso Viejo, CA 92656

(949) 855-1246